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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,480	10/05/2005	Steven P Buysse	2134CONCIPPCTUS	2853

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UNITED STATES SURGICAL,
A DIVISION OF TYCO HEALTHCARE GROUP LP
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EXAMINER

YABUT, DIANE D

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/516,480

Applicant(s)

BUYSSE ET AL.

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/20/06; 5/30/06; 3/15/06</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 5/6/05; 2/24/05</u> |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 24 February 2005, 6 May 2005, 15 March 2006, 30 May 2006, and 20 November 2006 are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

3. It is the examiner's position that applicant has invoked 35 U.S.C. 112, sixth paragraph in Claim 1 by reciting "means for connecting" (also in Claim 8) and "means for maintaining." Therefore the examiner requires the applicant to clarify the record by amending the specification to "explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element." MPEP 2181(IV). Please note that the MPEP clearly states that "[e]ven if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...." (MPEP 2181(IV)). Appropriate correction is required.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 12, line 17 “electrically conductive tube **13**.” On page 10, lines 4-5 “inner insulator **34**” and “outer insulator **35**.” On page 11, line 10 “handgrip **53**.”

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 2-3 are objected to because of the following informalities: On line 2 of Claim 2 it reads “connecting means includes” and should rather read --means for connecting include--. On line 2 of Claim 3 it reads “maintaining means includes” and should rather read --means for maintaining include--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1 and 3-17 are rejected under 35 U.S.C. 102(a) as being anticipated by **Couture** (U.S. Pub. No. **20020188294**).

Claims 1 and 7-9: Couture discloses a handle having an elongated tube **18** affixed thereto, the tube including first and second jaw members **110**, **120** attached to a distal end thereof, the jaw members being movable from a first position for approximating tissue to at least one subsequent position for grasping tissue therebetween, each of the jaw members including an electrically conductive sealing surface, the handle including a fixed handle **50** and a movable handle **40**, the movable handle being movable relative to the fixed handle to effect movement of the jaw members from the first position to the at least one subsequent position for grasping tissue, the opposable sealing surfaces including a non-stick material coating which is deposited on the opposable sealing surfaces for reducing tissue adhesion during sealing process, means for connecting **300** the jaw members to a source of electrosurgical energy such that the opposable seal surfaces are capable of conducting electrosurgical energy through tissue held therebetween, a stop **150a** for maintaining a minimum separation distance of at least about 0.03 millimeters, or in the range of about 0.03 millimeters to about 0.16 millimeters, between opposable sealing surfaces, and means for maintaining **30**, **22**, **21**

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a closure force in the range of about 3 kg/cm² to about 16 kg/cm² between opposable sealing surfaces (Figures 1A, 7; page 4, paragraphs 69-70; page 5, paragraph 74; page 12, paragraph 141; page 14, paragraph 162; page).

Claims 3-4: Couture discloses the maintaining means including a ratchet disposed within the fixed handle **50** and at least one complimentary interlocking mechanical interface disposed on the movable handle **40**, the ratchet and the complimentary interlocking mechanical interface providing at least one interlocking position for maintaining a closure force within the range of about 7 kg/cm² to about 13 kg/cm² or about 4 kg/cm² to 6.5 kg/cm² between opposable sealing surfaces (page 5, paragraph 78; page 14, paragraph 162).

Claims 5-6: Couture discloses the stop **150a** being disposed on or disposed adjacent to at least one of the sealing surfaces (page 11, paragraph 132).

Claims 10-11 and 13-14: Couture discloses the non-stick coating being selected from a group of materials consisting of nitrides and nickel/chrome alloys, including at least one of: TiN; ZrN; TiAlN; CrN; nickel/chrome alloys with a Ni/Cr ratio of approximately 5:1; Inconel 600; Ni200; and Ni201 (page 2, paragraph 20).

Claim 12: Couture discloses the opposable sealing surfaces being manufactured from a non-stick material (page 14, paragraph 163).

Claims 15-17: Couture discloses at least one of the jaw members, handles and elongated tube including an insulative material serving as a coating or sheath disposed thereon (page 7, paragraph 99).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Couture** (U.S. Pub. No. **20020188294**) in view of **Stone** (U.S. Pat. No. **5,573,534**).

Claim 2: Couture discloses the claimed device, including means for connecting the jaw members to a source of electrosurgical energy including a conductive tube **310**, except for a pushrod for connecting a first jaw member to a source of electrosurgical energy.

Stone teaches a pushrod **22** for connecting a first jaw member to a source of electrosurgical energy (Figure 1, col. 3, lines 15-21, col. 5, lines 60-67 to col. 6, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a pushrod for connecting a jaw to a source of electrosurgical energy, as taught by Stone, to Couture in order for the interior of the device to be space efficient and for the actuator to have multiple functions, as well as eliminating the need for a separate connection mechanism.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Aranyi** (U.S. Patent No. **5,509,922**) discloses an endoscopic instrument with electrosurgical jaws with a stop for maintaining a separation distance between sealing surfaces and a means for maintaining closure force; **Sekino** (U.S. Patent No. **6,270,497**) discloses a pushrod that connects a jaw member to an electrosurgical source.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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DY

A handwritten signature in black ink, appearing to read "M. J. Hayes", with a stylized, flowing script.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER